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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial Number: 10/644,889

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Title: Rotatable Handle for
Reciprocating Saws

Art Unit: 3724

Examiner: Douglas Watts

Atty. Docket No.: 54525.000106

**SECOND SUGGESTION OF
INTERFERENCE
UNDER 37 C.F.R. § 41.202**

A. INTRODUCTION

Presented below is a second suggestion, pursuant to 37 C.F.R. § 41.202, for a declaration of interference between the above-identified U.S. Application No. 10/644,889 (hereinafter "the present application") assigned to Porter-Cable Corporation and U.S. Patent No. 6,912,790 assigned to Milwaukee Electric Tool Corporation (hereinafter "the Milwaukee '790 patent"). The present application and the Milwaukee '790 patent are both generally directed to a reciprocating saw with a rotating handle. In the present application, a Preliminary Amendment was filed on March 26, 2004, with claims copied from U.S. Application No. 10/011,251 (hereinafter "the Milwaukee '251 application") that issued as the Milwaukee '790 patent. A proposed count for the interference is set forth in Appendix A.¹

Applicants filed a first Suggestion of Interference on December 21, 2004 in the present application. The U.S. Patent and Trademark Office (USPTO) issued a communication on April 21, 2005 indicating that all the copied claims were allowable but that due to a potential interference, *ex parte* prosecution was suspended for a period of six months. The Milwaukee

¹ All of the Appendices for this Second Suggestion of Interference are identical to those Appendices attached to the Request for Declaration of Interference filed December 21, 2004, except for Appendix B. Accordingly, Applicants are providing herewith only a copy of the revised Appendix B. If the Examiner would like a complete copy of all the Appendices including the revised Appendix B, Applicants will provide one promptly upon request.

'251 application subsequently issued on July 5, 2005 as U.S. Patent No. 6,912,790. Milwaukee Electric Tool Corporation sued Black & Decker² on July 5, 2005 in the U.S. District Court for the Western District of Wisconsin alleging infringement of the Milwaukee '790 patent.

B. SUGGESTION OF INTERFERENCE

Below is the information required by 37 C.F.R. § 41.202(a) under headings that correspond to the six subsections of § 41.202(a).

1. Identification of Patent and Application

Applicants hereby request that the USPTO declare an interference between:

- (a) U.S. Application No. 10/644,889 to Gist et al. (the present application), filed August 20, 2003, entitled "Rotatable Handle for Reciprocating Saws," assigned to Porter Cable Corporation (which claims priority to U.S. Provisional Application No. 60/404,634, filed August 20, 2002); and
- (b) U.S. Patent No. 6,912,790 to James et al. (the Milwaukee '790 patent), filed December 3, 2001, entitled "Handle Arrangement for a Reciprocating Saw," assigned to Milwaukee Electric Tool Corporation.

2. Identification of Interfering Claims; Presentation of Proposed Counts; Showing of Correspondence Between Interfering Claims and Proposed Counts

a. Presentation of Proposed Counts

Presented below is a proposed Count. The proposed count is also set forth in Appendix

A.

Count:

A reciprocating saw comprising:

a reciprocatable spindle for supporting a saw blade for reciprocating sawing movement;

a body defining a longitudinal pivot axis and housing a motor and a drive mechanism driven by the motor, the drive mechanism selectively driving the spindle, the body having a forward end supporting the spindle and a rearward end; and

a grip engageable by a hand of an operator, the grip being connected to the rearward end of the body for pivoting movement relative to the body about the pivot axis.

² Black & Decker acquired Porter Cable Corporation in October 2004.

b. Identification of Interfering Claims

In accordance with § 41.202(a)(2), Applicants respectfully submit that the interfering claims are claims 37-81 of the present application and claims 1-62 of the Milwaukee '790 patent.

c. Showing of Correspondence Between the Interfering Claims and the Proposed Counts

i. Claims of the Present Application Corresponding to the Count

Claims 37-81 of the present application correspond to the Count. Applicants first address the correspondence of the independent claims to the Count.

Independent claim 72 of the present application corresponds exactly to the Count, and is thus necessarily anticipated by the Count.

Independent claim 37 of the present application corresponds substantially to the Count. Independent claim 37 of the present application differs from the Count in the recitation of a grip axis oriented at an angle of between thirty degrees and ninety degrees relative to the pivot axis. This feature, however, has been used in reciprocating saws for many years and is well known in the art. Accordingly, the Count renders the subject matter of independent claim 37 obvious and therefore independent claim 37 corresponds to the Count.

Independent claim 48 of the present application corresponds substantially to the Count. Independent claim 48 of the present application differs from the Count in that independent claim 48 recites that the pivot axis *extends between the forward and the rearward end of the body*, whereas the Count recites a *longitudinal* pivot axis. However, this difference in terminology does not constitute a patentable distinction. The longitudinal pivot axis of the body extends between the forward and the rearward end of the body. *See also* Notice of Allowability in the Milwaukee '251 application, August 19, 2004, at 2 ("From the prosecution history of the case it was felt that applicant had attempted to state that the 'pivot axis' was a longitudinal axis as set forth in the specification. The amendments to the claims however leave no doubt as to this limitation." Claim 17 of the Milwaukee '790 patent was amended to recite "the pivot axis extending between the forward and the rearward end" of the body. Claim 17 of the Milwaukee '790 patent is identical to independent claim 48 of the present application.). Accordingly, the Count renders the subject matter of independent claim 48 obvious and therefore claim 48 corresponds to the Count.

Independent Claim 54 of the present application corresponds substantially to the Count. Independent claim 54 of the present application is identical to the Count except that independent claim 54 recites a “D-shaped handle,” whereas the Count recites a “grip.” The feature of a D-shaped handle, however, has been used in reciprocating saws for many years and is well known in the art. Accordingly, the Count renders the subject matter of independent claim 54 obvious, and therefore independent claim 54 corresponds to the Count.

Independent claim 69 of the present application corresponds substantially to the Count. Independent claim 69 of the present application differs from the Count in the recitation of an annular projection engaged with and traveling in an annular groove during pivoting movement of the grip about the pivot axis. This feature, however, is well known in the art. Accordingly, the Count renders the subject matter of independent claim 69 obvious and independent claim 69 corresponds to the Count.

Dependent claims 38-47, 49-53, 55-68, 70-71 and 73-81 of the present application merely further define elements of independent claims 37, 48, 54, 69 or 72, respectively, or recite the addition of elements that were known for use in the relevant art. As such, they are not believed to define separately patentable subject matter, and should be designated as corresponding to the Count along with independent claims 37, 48, 54, 69, and 72 of the present application.

ii. Claims of the Milwaukee ‘790 Patent Corresponding to the Count

Claims 1-62 of the Milwaukee ‘790 patent correspond to the Count. Applicants first address the correspondence of the independent claims to the Count.

Independent claim 50 of the Milwaukee ‘790 patent corresponds exactly to the Count, and is thus necessarily anticipated by the Count.

Independent claim 1 of the Milwaukee ‘790 patent corresponds substantially to the Count. Independent claim 1 differs from the Count in the recitation of a grip axis oriented at an angle of between thirty degrees and ninety degrees relative to the pivot axis. This feature, however, has been used in reciprocating saws for many years and is well known in the art. Accordingly, the Count renders the subject matter of claim independent 1 obvious and therefore independent claim 1 corresponds to the Count.

Independent claim 17 of the Milwaukee ‘790 patent corresponds substantially to the Count. Independent claim 17 differs from the Count in that claim 17 recites that the pivot axis *extends between the forward and the rearward end of the body*, whereas the Count recites a

longitudinal pivot axis. However, as explained above in connection with independent claim 48 of the present application, this difference in terminology does not constitute a patentable distinction. Accordingly, the Count renders the subject matter of independent claim 17 obvious and therefore independent claim 17 corresponds to the Count.

Independent claim 26 of the Milwaukee '790 patent corresponds substantially to the Count. The primary difference between the Count and independent claim 26 is that the Count recites a "grip," whereas independent claim 26 recites a "D-shaped handle." The feature of a D-shaped handle, however, is well known in the art. Accordingly, the Count renders the subject matter of independent claim 26 obvious and independent claim 26 corresponds to the Count.

Independent claim 46 of the Milwaukee '790 patent corresponds substantially to the Count. Independent claim 46 differs from the Count in the recitation of an annular projection engaged with and traveling in an annular groove during pivoting movement of the grip about the pivot axis. This feature, however, is well known in the art. Independent claim 46 also differs from the Count in that claim 46 recites a "pivot axis" whereas the Count recites a "longitudinal pivot axis."³ However, the "pivot axis" recited in claim 46 would have been obvious in view of the "longitudinal pivot axis" recited in the Count. Accordingly, the Count renders the subject matter of independent claim 46 obvious and independent claim 46 corresponds to the Count.

Dependent claims 2-16, 18-25, 27-45, 47-49 and 51-62 of the Milwaukee '790 patent merely further define elements of independent claims 1, 17, 26, 46 or 50 or recite the addition of elements which were known for use in the relevant art. As such, they are not believed to define separately patentable subject matter, and should be designated as corresponding to the Count along with independent claims 1, 17, 26, 46 and 50 of the Milwaukee '790 patent.

3. Claim Charts Comparing Each Party's Correspondence to the Counts and Showing of Why the Claims Interfere

In accordance with 37 C.F.R. § 41.202(a)(3), attached Appendix B sets forth a side-by-side comparison of the Count, independent claim 72 of the present application, independent claim 50 of the Milwaukee '790 patent, and a showing of why these claims interfere pursuant to 37 C.F.R. § 41.203(a).⁴

³ During prosecution, the Examiner added the word "longitudinal" to corresponding application claim 47 by Examiner's amendment. See Milwaukee '251 application, Notice of Allowability, August 19, 2004, at 2 ("in claim 47 line 4 before 'pivot' insert -longitudinal-"). This amendment, however, is missing from issued claim 46.

⁴ 37 C.F.R. § 41.203(a) provides:

4. Explanation of Why Applicants Will Prevail On Priority

Applicants conceived of the invention defined by the Count prior to December 3, 2001⁵ and demonstrated diligence from a time prior to December 3, 2001 in actually reducing to practice the invention defined by the Count, which occurred in March 2002. Appendices F, G and H attached hereto are Affidavits, respectively, of inventor Leslie Daily Gist, Darwin Keith-Lucas, and Robert Pigg. The Affidavits set forth the facts and circumstances that form the basis of a *prima facie* case of prior invention by Applicants. Appendices I - O contain documentary evidence of conception, diligence and actual reduction to practice of Applicants' invention.

Prior to December 3, 2001, Leslie Daily Gist ("Gist"), Darwin Keith-Lucas ("Keith-Lucas"), Mark Etter ("Etter") and Angela Shelton ("Shelton") attended a meeting during which Gist conceived of the invention defined by the Count reproduced in Appendix A. Gist Affidavit ¶ 5. During that meeting, Gist described the invention defined by the Count of Appendix A to Keith-Lucas, Etter and Shelton. Gist Affidavit ¶ 6. During that meeting, Gist made a drawing of the invention and showed the drawing to Keith-Lucas, Etter, and Shelton. Gist Affidavit ¶ 7. The drawing is reproduced in Appendix I. The drawing shows a reciprocating saw that includes all the elements of the proposed count, *i.e.*, a spindle, a saw blade, a body housing a motor and a drive mechanism that drives the spindle, and a grip that pivots relative to the body about a longitudinal pivot axis of the body. Gist Affidavit ¶ 7.

Subsequent to the conception referred to above, and prior to December 3, 2001, Keith-Lucas worked diligently towards reducing to practice the invention defined by the Count in Appendix A as part of Porter-Cable's TigerSaw product development effort. Keith-Lucas Affidavit ¶ 6. Porter-Cable's TigerSaw product is a reciprocating saw. Keith-Lucas Affidavit ¶

(a) *Interfering subject matter.* An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.

⁵ Applicants are aware that the inventors of the Milwaukee '790 patent have alleged a date of September 6, 2001 as their invention date. See Milwaukee '251 application, Declaration of Prior Invention Under 37 C.F.R. § 1.131, Paper No. 15, filed April 8, 2004 (Attached as Appendix E) (hereinafter "Rule 131 Declaration"). The Rule 131 Declaration, however, does not satisfy the requirements of 37 C.F.R. § 1.131. In particular, the Rule 131 Declaration does not include a *showing of facts* such as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or the filing of the application. Because Milwaukee's Rule 131 Declaration does not demonstrate that Milwaukee is *prima facie* entitled to a date of invention of September 6, 2001, Applicants' requirement to show priority under 37 C.F.R. § 41.202 is satisfied by demonstrating a date of invention prior to Milwaukee's filing date of December 3, 2001.

6. Copies of TigerSaw Team Notes showing diligence in reducing the invention to practice as part of Porter-Cable's TigerSaw product development effort, from a time prior to December 3, 2001, until actual reduction to practice in March 2002, are set forth in Appendix J. Keith-Lucas Affidavit ¶ 6. Keith-Lucas designed features and dimensions of a rotatable handle for Porter-Cable's TigerSaw reciprocating saws during the period from prior to December 3, 2001 until actual reduction to practice of the invention. Keith-Lucas Affidavit ¶ 6. As part of his design work, Keith-Lucas created drawings of a reciprocating saw with a rotatable handle prior to December 3, 2001. These drawings are reproduced in Appendix K. Keith-Lucas Affidavit ¶ 6. Keith Lucas created similar drawings after December 3, 2001 which are reproduced in Appendix L. Keith-Lucas Affidavit ¶ 6. As part of his design work, prior to December 3, 2001, Keith-Lucas built a model of a TigerSaw reciprocating saw that included a rotating handle. Photographs of the model are reproduced in Appendix M. Keith-Lucas Affidavit ¶ 6.

In or around November 2001, Robert Pigg ("Pigg") began working on the TigerSaw product development team at Porter-Cable Corporation. Pigg Affidavit ¶ 3. Pigg personally worked diligently towards building a prototype of the invention defined by the Count set forth in Appendix A from the beginning of his involvement in November 2001 with Porter-Cable's TigerSaw product development effort until the prototype was built and shown to work for its intended purpose in March 2002. Pigg Affidavit ¶ 3. During Pigg's work of building a prototype of the invention, Pigg had discussions with Keith-Lucas regarding the rotatable handle feature of the TigerSaw product, in which Keith-Lucas conveyed design information on features of the rotating handle. Pigg Affidavit ¶ 4. As part of Pigg's work building a prototype of the invention, he created manufacturing drawings for the rotatable handle feature of the invention. Pigg Affidavit ¶ 4. These drawings are reproduced in Appendix N and they bear the date of March 4, 2002. Pigg Affidavit ¶ 4. In or around March 2002, Pigg completed the prototype of the invention defined by the Count set forth in Appendix A. Pigg Affidavit ¶ 5. Photographs of the prototype are reproduced in Appendix O. Pigg Affidavit ¶ 5. The prototype shown in Appendix O is a reciprocating saw that included all the elements of the proposed count, *i.e.*, a spindle for supporting a saw blade, a body housing a motor and a drive mechanism that drives the spindle, and a grip that pivots relative to the body about a longitudinal pivot axis of the body. Pigg Affidavit ¶ 5. In or around March 2002, Pigg determined that the prototype shown in Appendix O worked for its intended purpose. Pigg Affidavit ¶ 6.

After building the prototype shown in Appendix O, Pigg provided information about the prototype to John Beville to assist with preparing a patent application relating to the prototype. Pigg Affidavit ¶ 7. Pigg also continued to work toward commercialization of the TigerSaw product. Pigg Affidavit ¶ 7. Pigg prepared a cost estimate for the rotating handle feature of the TigerSaw product that is reproduced in Appendix P. Pigg Affidavit ¶ 7. One of the documents in Appendix P, entitled “Rot-handle cost estimate,” bears the date of April 8, 2002. Pigg Affidavit ¶ 7.

After the actual reduction to practice in March 2002, Porter-Cable Corporation filed U.S. Provisional Application No. 60/404,634 on August 20, 2002, constituting a constructive reduction to practice of the invention defined by the Count in Appendix A.

5. Claim Chart Showing Written Description for Each Claim in Applicant’s Specification

In accordance with 37 C.F.R. § 41.202(a)(5), attached Appendix C sets forth the written description support for each of Applicants’ claims that have been added or amended to provoke the present interference.

6. Chart Showing Support for a Constructive Reduction to Practice Within the Scope of the Interfering Subject Matter

In accordance with 37 C.F.R. § 41.202(a)(6), attached Appendix D sets forth exemplary disclosure showing constructive reduction to practice within the meaning of § 41.201⁶ of representative claims of the present application within the scope of the interfering subject matter corresponding to the Count.

C. CONCLUSION

Applicants respectfully suggest that the USPTO declare an interference between claims 37-81 of the present application and claims 1-62 of the Milwaukee ‘790 patent, all of which correspond to the proposed Count.

Applicants also respectfully request that the USPTO withdraw the six-month suspension of prosecution issued April 21, 2005 in the present application. Applicants are unaware of any

⁶ 37 C.F.R. § 41.201 provides:

Constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. 102(g)(1) in a patent application of the subject matter of a count. *Earliest constructive reduction to practice* means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent.

reason that prosecution should be suspended in the present application and respectfully submit that the suspension is arbitrary and should be withdrawn immediately.

It is believed that no fees are due with this Suggestion. However, if any fees are required, authorization is hereby granted to charge those fees to the undersigned representative's deposit account no. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: Aug. 25, 2005

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